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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/488,180	06/07/1995	WALTER P. CARNEY	40441-CY/IPW	8467

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EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT PAPER NUMBER

1642

DATE MAILED: 01/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/488,180

Applicant(s)

CARNEY ET AL.

Examiner

Sheela J Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-24 is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 16-27 are pending.

Claims 16-24 remain allowed.

Claims 25-27 are subject to the following rejections.

***Priority***

As discussed in paper no. 12, mailed 10/11/01, applicant is entitled to a date of 9/29/89.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 25-27 are rejected under 35 U.S.C. 102(a) as being anticipated by McKenzie et al Oncogene 4(5):543 (May 1989).

This reference discloses hybridoma cell lines secreting OD3 (HB10204, NB-3 (HB 10205) and TA-1 (HB 10206), all of which bind the extracellular domain of the human neu gene product.

Claims 25-27 are rejected under 35 U.S.C. 102(a) as being anticipated by Masuko et al Jp. J. Cancer Research vol. 80 p. 10(189).

The reference discloses a hybridoma cell line secreting monoclonal antibody SV2-61, which binds the extracellular domain of the human neu gene product.

Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Ring US 6054561.

This reference discloses a substantially purified human neu related protein comprising the extracellular domain of a neu related gene product and which has a molecular weight from about 95000Da to about 115000 Da and the antibody which binds such (113F1) (see abstract, col. 5, lines 24-40 and col. 27 lines 1-40).

Claims 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudziak et al US 5720937 or 5772997.

Hudziak et al '937 discloses a monoclonal antibody (4D5), which binds a substantially purified human neu related protein comprising the extracellular domain of a neu related gene product and which has a molecular weight from about 95000 Da to about 115000 Da (see abstract and col. 18).

Hudziak et al '997 discloses a monoclonal antibody (4D5) which binds a substantially purified human neu related protein comprising the extracellular domain of a neu related gene product and which has a molecular weight from about 95000 Da to about 115000 Da (see claims and col. 18).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-

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7866. The examiner can normally be reached on T,Th 6am-12pm and alternate Mondays 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Sheela J Huff  
Primary Examiner  
Art Unit 1642

sjh  
January 21, 2003